

E2  
29. (Once Amended) An isolated polypeptide comprising a mature portion of a protein as encoded by the vascular endothelial growth factor-3 (VEGF-3) cDNA clone contained in ATCC Deposit No. [97116] 97166.

E3  
35. (Once Amended) An isolated polypeptide, comprising a fragment of at least 50 amino acids encoded by the cDNA contained in ATCC Deposit No. [97116] 97166, wherein said fragment binds an antibody having specificity for the polypeptide of SEQ ID NO:2.

E4  
37. (Once Amended) An isolated polypeptide, comprising a fragment of at least 50 amino acids encoded by the cDNA contained in ATCC Deposit No. [97116] 97166, wherein said fragment has angiogenic activity.

**Remarks**

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendments, claims 26-65 are pending in this application. Claims 27, 29, 35 and 37 have been amended to correct typographical errors. These amendments reflect the true ATCC Deposit No. concerning the deposited cDNA clone and thus do not introduce new matter.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Objection to the Specification***

The amendment filed on March 3, 1998 has been objected to because it attempts to incorporate subject matter by reference. According to the Examiner:

[This amendment] is improper because it is not in conformance with M.P.E.P. 608.04(b) because the amendment was not part of the original disclosure. Such amendment does not enjoy the status as part of the original disclosure in an application filed under 37 CFR 1.53 unless it is referred to in the oath or declaration filed therewith.

It is on these grounds that the Examiner requests the recitation "which disclosure is herein incorporated by reference" be deleted from the continuing data as being new matter.

Applicants believe that the amendment is proper and reconsideration is requested. The amendment merely attempts to indicate that the disclosure of U.S. Appl. No. 08/469,641, of which the present application is a divisional, is incorporated by reference into the present application. The declaration filed on March 3, 1998 with the present application is a copy of the declaration submitted in U.S. Appl. No. 08/469,641. Thus, the declaration already refers to the material which applicants intend to incorporate by reference. To amend the specification to incorporate by reference the application referred to in the declaration does not introduce new matter.

Additionally, further evidence that this is proper is provided by the PTO itself on form PTO/SB/05, where incorporation by reference is an element available in the "Application Elements" box. In form PTO/SB/05, element 5 allows for:

Incorporation By Reference (useable if Box 4b is checked)  
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference within.

Box 4b indicates inclusion of a copy of an Oath or Declaration from a prior application for a continuation/divisional application, as allowed by 37 C.F.R. § 1.63(a). Thus, incorporating by reference a prior application of which a copy of a declaration is used is allowable on form PTO/SB/05. Therefore, Applicants believe that no new matter is being introduced into the current application by the amendment filed on March 3, 1998. As allowed by 37 C.F.R. § 1.63(a), the present application's declaration is a copy from the parent application, allowing for the incorporation by reference of the contents of the parent application, into the present application.

***Rejection Under 35U.S.C. § 112***

The examiner rejected claims 27, 29, 35, 37, 39, 41, 47, 49, 51, 54, 56, 58, 60, 63 and 65 under 35 U.S.C. § 112 as failing to meet the enablement requirement. Applicants appreciate the Examiner's suggestion that the enablement requirements of 35 U.S.C. § 112 may be satisfied by a declaration. Applicants have deposited a plasmid containing human cDNA encoding a Human Vascular Growth Factor 3 under the terms of the Budapest Treaty and have included with this reply a Statement Concerning the Deposited cDNA Clone. Accordingly, withdrawal of this rejection is respectfully requested.

***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the

Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: September 2, 1999

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hu *et al.*

Appl. No. 09/033,662

Filed: March 3, 1998

For: **Human Vascular Endothelial  
Growth Factor 3**



Art Unit: 1646

Examiner: Saoud, C.

Atty. Docket: 1488.1040001/RCM/AJK

**Statement Concerning the Deposited cDNA Clone**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

A plasmid containing human cDNA encoding a Human Vascular Growth Factor 3 polypeptide was deposited under the terms of the Budapest Treaty on May 26, 1995 at the American Type Culture Collection, Patent Depository, 10801 University Boulevard, Manassas, VA 20110-2209 (current address), and given accession number 97166.

Assurance is hereby given that: (1) the deposit was made under terms of the Budapest Treaty; and (2) except for the limitations allowed by 37 C.F.R. § 1.808(b), all restrictions on the availability to the public of the deposit will be irrevocably removed upon the granting of a patent.

The undersigned hereby declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code

and that such willful false statements may jeopardize the validity of the instant patent application or any patent issuing thereon.

Date: 8/26/99

By: James H. Davis  
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